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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,341	12/13/2001	Tom Steinke	STEINKE.005A	6810

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,341

Applicant(s)

STEINKE, TOM

Examiner

Michael Thaler

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 12-14 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for "each radial element" and "the radial elements" in these claims.

Claims 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fordenbacher (5,733,328) in view of Ryan (5,830,217). Fordenbacher, in figures 7-9 discloses a catheter having an expandable member (the balloon catheter described in col. 7, lines 21-24) coupled to an expansion actuator (the source of inflation fluid for the balloon catheter) and a stent (e.g. the stent shown in figure 7) comprising a tubular member comprising a series of sliding and locking circumferential elements 40, 42 (noting that more than two elements may be used to form a "series" as indicated in col. 7, lines 7-14), wherein each element is structurally separate from the other elements and forms only a fraction of the circumference of the tubular member and at least one articulating mechanism that permits one-way sliding of the radial elements but prevents recoil from the expanded diameter (noting the phrase "little or no recoil" in col. 6, lines 46-48 and noting the arresting mechanisms described in col. 8, lines 52-64). Fordenbacher fails to

Art Unit: 3731

disclose a degradable polymeric coating that holds the stent on the expandable member. However, Ryan teaches that a polymeric coating should be applied to a stent and expandable member in order to obtain the advantage of keeping the stent securely attached to the catheter until deployment is desired (col. 2, lines 35-38 and col. 2, line 64 to col. 3, line 9). It would have been obvious to include a polymeric coating on the Fordenbacher stent and expandable member so that it too would have this advantage. Note that Ryan discloses polyethylene glycol, for example, as the polymer (col. 6, lines 44-51). As to claim 11, note col. 8, lines 60-62 of Ryan. As to claims 13 and 14, Fordenbacher fails to disclose radial elements that alternate between radial elements having one rib and radial elements having two ribs. However, it is old and well known in this art to provide such an arrangement in order to provide enhanced strength to the stent. It would have been obvious to this arrangement for the Fordenbacher stent so that it too would have this advantage. The above well known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion (M.P.E.P. 2144.03).

Applicant's arguments filed Oct. 31, 2005 have been fully considered but they are not persuasive. The argument that, in applicant's invention, there are no ends of the elements free to

Art Unit: 3731

protrude into the lumen or outward to the wall of the vessel is not relevant since this feature is not claimed. Although the circumferential elements 40 and 42 of Fordenbacher each include a backbone (e.g. zig zag backbone 44 on element 40), the claims do not preclude this. Note that the entire element 40, for example, is considered to be one of the claimed circumferential elements.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael

Art Unit: 3731

Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
12/28/05



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731